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| IP Department Patton Boggs, LLP 2001 Ross Avenue Suite 3000 Dallas, TX 75201 | | | EXAMINER NUTTER, NATHAN M | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,094

Applicant(s)

HOLMES ET AL.

Examiner

Nathan M. Nutter

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 19-27 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 28-45, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 June 2009 has been entered.

Claim Interpretations

The recitations in the broad claims embrace constituents known to be employed together in various combinations. The recitations of the several ingredients of the formulations of the dependent claims 7-9 and 16-18, due to the number of required constituents, necessarily would not be found within the confines of a single reference. At paragraph [0025], the Specification discloses the "toasted oak dust" as "sometimes used by wineries to enhance the flavor of wine," and that "(w)hen added to the silicone-based compound...gives the resulting product a mottled, speckled, or non-uniform appearance that closely resembles natural cork." Since the "toasted oak dust" is disclosed as being for appearance, it will be viewed as a filler chosen for this aspect. Further, the Specification discloses at paragraph [0025] that "*untoasted* oak dust could also be used to obtain *similar results* (emphasis added)." The employment of the pigment is disclosed for aesthetic coloration. The employment of ethynyl cyclohexanol

as a platinum catalyst inhibitor (as a regulator) in the silicone resin composition is disclosed at paragraph [0027]. The employment of silicon hydride is disclosed as being "added to insure that the catalyzing reaction works properly," is assumed to be regarded that it is employed as a platinum catalyst coordinating compound, as is known in the prior art.

Response to Amendment

In response to the amendment filed 17 June 2009, the following is placed in effect.

New grounds of rejection follow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18, 28-45, 47 and 48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-12 and 14-18 of copending Application No. 11/598,553 (US 2007/0203266) Holmes et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the constituents overlap for each component, as herein claimed. Looking to the Specification to understand the full metes and bounds of the claims shows the inclusion of zinc ferrite at paragraph [0028].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The concept of "oak dust that does not consist of natural cork" which is critical or essential to the practice of the invention, but not

included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The recitation finds no support in the Specification, as filed. Applicants cannot rely on the Declaration of Tiberia to provide support or assumed from applicants' arguments. The concept finds no support in the Specification, as originally filed. The term oak dust is clearly deemed to include that from the cork oak. The negative limitation finds no support in the Specification, as originally filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 28-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) or Merguriya (US 6,506,331), each, taken in view of Dewar (US 6,022,816), and further in view of Descamps et al (US 5,162,397), Strauss (US 4,031,059) and Snogren (US 3,296,153) all taken together.

The reference to Oka et al (WO 03/020817) teaches the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Paragraphs [008] through [0010] show the resin (including claims 2

and 11). The fumed silica is included at paragraph [0011]. The use of cross-linking agents include an organic peroxide (claims 5 and 14) at paragraph [0013] and chloroplatanic acid (claims 4 and 13) at paragraph [0017]. Those citations teach the amounts claimed for each compositional limitation, as embraced by the reference. The reference also teaches the use of the pigments at paragraph [0027] and 1-ethynyl-cyclohexanol, used as a curing inhibitor, at paragraph [0028] as recited in instant claims 8, 9, 17 and 18.

The patent to Merguriya et al (US 5,981,610) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (lines 19 et seq.) for the resin. Note the paragraph bridging column 3 to column 4 for the use of fumed silica as a known thixotropic agent. Note column 4 (lines 17-22) for the use of chloroplatanic acid, as recited in claim 4. The use of a hollow filler is shown at column 4 (lines 27-48). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed. The reference also teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 5, bridging column 8 to column 9. At column 5 (lines 1-16) the reference teaches the use of carbon black, zinc white, known colorants. Both features as recited in instant claims 8, 9, 17 and 18.

The patent to Merguriya (US 6,506,331) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as

contemplated and herein claimed. Note column 2 (line 51) to column 3 (line 34) for the resin. Note column 5 (lines 1-16) for the use of fumed silica as a filler. Note column 4 (lines 34-52) for the use of chloroplatanic acid, as recited in claim 4, and (lines 53-64) for the peroxide component. The use of a hollow filler is shown at column 5 (lines 17-64). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed. The reference to Merguriya (US 6,506,331) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 1, column 7, and the use of carbon black and zinc white at column 5 (lines 1-16).

The references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) each show the broad composition of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed.

The reference to Dewar (US 6,022,816) teaches the production of a composite for the manufacture of closures (eg stopper) that may include a silicone polymer with a filler of "oak chips and/or splinters" to "provide a rustic 'freckled' appearance," essentially as taught in the instant Specification at paragraph [0025]. A crosslinker for the resin is shown at column 3 (lines 14-21) including the instantly claimed hydrogen peroxide.

The reference to Descamps et al (US 5,162,397) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 2 (lines 30 et seq.), a cross-linking agent of chloroplatanic acid at column 10

(lines 9 and 10) with a silica filler at column 7 (lines 9-16) and a microsphere agent, including the borosilicates of claims 3, 7-9, 12 and 16-18. Note column 1 (lines 50-66) and column 10 (lines 15-24 and 43-63) for the borosilicates and their compositional limitations. The reference teaches the conventionality of using a platinum catalyst inhibitor, such as an acetylenic alcohol (ethynyl cyclohexanol is one) at column 4 (lines 1-25). Carbon black may be included at column 7 (lines 8-16).

The reference to Strauss (US 4,031,059) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 13 (line 31) to column 14 (line 12), with hollow microspheres at column 14 (lines 36 et seq.), a curing agent and a silica filler. Note the Examples. The reference teaches the inclusion of ground cork at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26). The reference is clear as to why ground cork, microspheres and other low density fillers are employed, and deemed essentially equivalent, at column 2 (lines 11-20) and column 4 (lines 59 et seq.) as having a "lower thermal conductivity and higher specific heat."

The reference to Snogren (US 3,296,153) teaches the manufacture of a resin filled composition that may comprise a polysiloxane with a curing agent. The reference further teaches at column 7 (lines 23-66) and Table III, the use of "granulated cork, charred granulated cork" and "small hollow micro spheres," which may be glass or ceramic materials and may comprise the borosilicates of the instant claims and silica as suitable filler materials. Note the many Examples.

The primary references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) all show the broad composition as conventional to include a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. The reference to Dewar shows the conventionality of using oak particles as a suitable filler for silicone resins. The secondary references are relied upon to show the conventionality of each of the various constituents recited in claims 3, 6-9, 12 and 16-18, including the borosilicate microspheres, the toasted oak dust ("charred granulated cork"), pigment, silicon hydride and ethynyl cyclohexanol in silicone resins, including those recited and claimed herein. Since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success. The manipulation of the compositional limitations, depending on availability of materials, anticipated physical characteristics and cost procedures for the manufacture would clearly be within the purview of an artisan skilled in this art. The primary references teach such levels of inclusion. As such, the instant claims would have been obvious to a practitioner in the art in view of the references cited, absent any showing of unexpected results.

Claims 1-18 and 28-45, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) or Merguriya (US 6,506,331), each, taken in view of Dewar (US 6,022,816), newly cited,

and further in view of Descamps et al (US 5,162,397), Strauss (US 4,031,059) and Snogren (US 3,296,153) as applied to claims 1-18 and 28-45 above, and further in view of Bäßler (US 5,997,627).

The references are all cited and for the reasons set out in the rejection, above.

The reference to Oka et al (WO 03/020817) teaches the use of pigments at paragraph [0027]. Merguriya et al (US 5,981,610) teaches the use of carbon black, zinc white, known colorants at column 5 (lines 1-16). Merguriya (US 6,506,331) teaches the use of pigments, including carbon black and zinc white at column 5 (lines 1-16). Descamps et al (US 5,162,397) shows the colorant carbon black included at column 7 (lines 8-16).

None of the references teach the inclusion of zinc ferrite, as recited in instant claims 47 and 48.

The reference to Bäßler teaches the use of zinc ferrite as a suitable colorant for silicone resins. Note column 2 (lines 58-65) and column 4 (lines 7-20) for the colorant and the resin. The reference may include other fillers, including fumed silica, at column 6 (lines 10-16).

The reference to Bäßler shows the conventionality of using the yellow pigment, zinc ferrite, in silicone resins, as herein claimed. The use thereof for its art-recognized function would be prima facie obvious to a skilled artisan. Nothing unexpected is seen by the choice thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

31 July 2009

Response to Arguments

Applicant's arguments filed 17 June 2009 have been fully considered but they are not persuasive.

All arguments of record are being maintained.

With regard to the rejection of the claims 28-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, applicants have failed to show where the limitation resides in the Specification, as originally filed. The Specification of a patent application is not filed with interpretation left to others, but rather in clear, concise written description to enable the artisan to make and/or use the invention. The offending language has not been pointed out. The disclosure at paragraph [0025] of the Specification says nothing about natural cork. The Tiberia declaration is not part of the written description. The website pointed to is not part of the written description. The term "natural cork" does not even appear in the Specification, as originally filed.

With regard to the rejection of the claims 1-18 and 28-45 under 35 U.S.C. 103(a) as being unpatentable over Oka et al, Merguriya et al ('610) or Merguriya ('331), with Dewar ('816) and further in view of Descamps et al, Strauss and Snogren, all of these references are drawn to composites, just as herein claimed. Applicants are reminded that the rejection was made under 35 USC 103 and not under 35 USC 102, using the combined teachings of each reference, as pointed out by the Examiner. Each reference does NOT have to teach each and every feature of each and every claim, as applicant mistakenly contends. The claims are drawn to filled silicone polymers. The references

each show aspects that are included. The references are each drawn to silicone compositions, variously filled with the constituents herein claimed. The references are cited for the reasons set out in the rejection. Applicants have not shown any definitive reference or reasoning that gives size to "oak dust" as to exclude "granulated cork" or "ground cork." Since the oak dust is filler (non-reactive) the size of the filler particle is a matter of design choice, product availability, cost concerns, etc. and applicants have failed to show any patentable differences. Again, the reference to Strauss clearly shows employment of "ground cork" as a filler choice at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26), and Snodgren teaches at column 7 (lines 23-66) and Table III, the use of "granulated cork, (and) charred granulated cork." It is not understood by the Examiner what more in this regard needs to be shown. Applicants have shown no criticality as to form of the oak filler and have not disclosed, nor claimed, any size limitations on their oak dust filler. Further, cork is clearly an oak. Applicants' claims fail to exclude large particle sizes or other types of oak/woody materials, even in large amounts since the claims recite "comprising." It is pointed out to applicant that other terms, such as flake, particle, pellet, chip, particulate, pulverulent, powder, flour, granulate, micropowder, microparticle, nanoparticle, etc., also, are not referred to by either Strauss or Snodgren since patentees do not have to disclose each and every possible term useful for a constituent. These terms are deemed to be synonymous. Applicant has failed to show by reference material or prior art that granulated or ground cork is larger in size. The assertion is not well-founded, either in science or reason. Nothing in the Specification teaches a size range. The nomenclature for a product does

not always fairly represent that product, either for what it is, what it is composed of or any size, shape or other characteristic, for example, peanut butter, cat litter, gypsum board, etc.. As such, applicants have provided no logical reasoning to negate the teachings of either Dewar, Snogren or Strauss. Applicants' assertions that the references fail to show the concept of the oak dust lacks credence in view of the lack of particle size disclosure.

Applicant contends the Examiner has failed to "provide an articulated reasoning with rational underpinnings" that a person having ordinary skill in the art would have an "apparent reason to combine the references in a manner that would render the claims obvious." The rejection has been set out with full reasoning, above. Applicant has chosen to ignore the reasoning, while attempting to affirm patentability with Declarations drawn to details that are not persuasive since they have no bearing on patentability. The references are drawn to analogous art, showing the constituents used conventionally. Nothing unexpected is seen, nor has such been shown. All of the various constituents are shown in their known conventional applications. Nothing has been shown on the record as to any criticality for choosing any of the components recited to establish surprising results. All constituents have been admixed as to their art-recognized functions. Nothing unexpected has been shown by this combination.

The combination of the teachings of the references, as clearly pointed out in the Office Action, renders the claim obvious primarily because such a combination of known elements is considered to yield predictable results insofar as the combined elements operate wholly in the expected and customary manner as previously recognized by

those skilled in the art. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, slip op. at 12 (2007) (explaining that the "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results"). Here, the Specification and/or Applicant's remarks provide no apparent evidence or reasoning supporting the conclusion that the claimed combination of known elements "work[s] together in an unexpected and fruitful manner" or "create[s] some new synergy," thereby rebutting the above contention that the claimed combination enacts little more than "the predictable use of prior art elements according to their established functions." *Id.* slip op. at 12-13.

In response to applicant's argument that "(t)he Strauss and Snodgren references are not analogous art," it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. *See In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are drawn to compositions of polysiloxane resins with fillers, as herein claimed. Applicants assert these references to be non-analogous since they are not "aimed at providing a substitute for natural cork" and "they reasonably pertinent to the particular problem with which the Applicant was concerned (i.e. providing a substitute for natural cork)." The references do not have to be "aimed at providing a substitute for natural cork" to be analogous since the instant claims are drawn to compositions, per se, not a method of

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"providing a substitute for cork." Nothing in the claims differentiates over the references, as applied in the rejection under 35 USC 103.